

### REMARKS

Claims 1-80 were previously pending the application and stand rejected. Claims 1-2, 4-6, 18, 25, 34, 37, 73-75, and 80 are amended as set forth above. New claims 81-83 have been added. The Applicant respectfully requests reconsideration of the application in view of the above amendments and the following remarks.

#### **A. The Applicant Requests that the Section 112 Rejections Be Withdrawn.**

In the Office Action dated May 5, 2004, claims 1-24, 34-36, 69-70, 73-75 and 80 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements. In particular, the Examiner asserts that the language in claim 1 reciting “*an indication of preferred providers identified by the consumer or by prior purchases thereby*” and reciting “*wherein the request includes a selected one of the at least one domain name*” was not described in the original specification in a manner sufficient to comply with the written description and enablement requirements. Claim 1 has been amended to replace the phrase “*an indication of preferred providers*” with “*a list of preferred providers.*” Support for this limitation in the original application can be found at least at page 26, lines 3-4. In addition, the phrase “*wherein the request includes a selected one of the at least one domain name*” has been amended as follows: “*wherein the request includes a selected one of the at least one domain name.*” Support for this limitation in the original application can be found at least at page 23, lines 5-16. Any instances in the remaining claims have been amended in an analogous manner. The Applicant therefore requests that the rejections under section 112, first paragraph, be withdrawn.

#### **B. The Cited References Fail to Teach or Suggest the Claimed Techniques with Respect to Independent Claims 1, 18, 25, and 37.**

Claims 1-4, 6-7, 9-11, 18-21, 24, 34, 36, 53-55, 61-63, and 69-70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Traderonline and further in view of Dean. Claim 1 has been amended to further recite “*completing a transaction between the consumer and a provider selected from the identified at least one provider*” and “*updating the personal information based on the completed transaction, wherein the updated personal information is*

accessible by the system for use in connection with a subsequent request initiated by the consumer that includes a different one of the plurality of domain names, with the domain name included in the subsequent request including an identification of the subject of the subsequent request.” Support for these added limitations can be found in the original application at least at page 14, lines 1-14, page 23, lines 1-4, and page 26, line 1, to page 27, line 5. None of the cited references teach or suggest updating personal information based on a completed transaction with a provider identified in response to a request that includes one of a plurality of domain names, with the domain name included in the request identifying a subject of the request, and allowing the updated personal information to be accessible for use in connection with a subsequent request that includes a different one of the plurality of domain names, with the different domain name identifying a subject of the subsequent request. Accordingly, claim 1 and its dependent claims are allowable over the cited references.

Claim 18 has been amended to recite that the server is further operable to “update the information associated with the consumer based on the completed transaction” and “access the updated information for use in connection with a subsequent request initiated by said consumer, wherein the subsequent request includes a different one of the plurality of domain names and the domain name included in the subsequent request identifying a subject of the subsequent request.” Similar to claim 1, the cited references fail to teach or suggest updating information associated with a consumer based on a completed transaction with a provider selected in response to a request that includes one of a plurality of domain names, with the domain name included in the request identifying a subject of the request, and accessing the updated personal information for use in connection with a subsequent request that includes a different one of the plurality of domain names, with the different domain name identifying a subject of the subsequent request. Accordingly, claim 18 and its dependent claims are allowable over the cited references.

Claim 25 has been amended to recite that “the information is updated for future use in selecting, responsive to a subsequent received request and based upon the updated information, at least one name of at least one provider.” Again, none of the cited references disclose or suggest updating information associated with a consumer: (1) based upon a chosen provider

with which to conduct business; and (2) for use in selecting a provider in response to a subsequent request. Claim 37 has also been amended in a similar manner. Accordingly, claims 25 and 37 and their respective dependent claims are allowable over the cited references.

**C. There is No Suggestion or Motivation to Combine the Cited References to Arrive at the Claimed Invention.**

All of the claim rejections under 35 U.S.C. § 103(a) rely upon a combination of at least the Traderonline and Dean references. However, there is no suggestion to combine the Traderonline and Dean references. An obviousness rejection must be supported by some suggestion, teaching, or motivation to combine prior teachings that is clear and particular; conclusory statements regarding the teaching of multiple references are insufficient. *In re Dembiczak*, 175, F.3d 994 (Fed. Cir. 1999). For example, with respect to at least claim 1, nothing in Traderonline suggests that it would be desirable to store personal preferences of consumers, and nothing in Dean suggests any reason to submit requests that include one of a plurality of domain names, which include an identification of a subject of the request. Dean discloses a system that uses a smart card to store personal data or a set of addresses, file names, and access details for retrieving user specific data. Because the personal information is stored on a smart card or is otherwise referenced by the smart card, there is no reason to combine the system described in Dean with a system in which domain names identify a subject of a request. In addition, Dean is directed to a system for retrieving user specific data, while the Traderonline reference is directed to a system that allows users to search for some previously unknown provider. Accordingly, the purposes of the respective systems are different, and there is no suggestion or motivation to combine the teachings of the references to produce the claimed invention. The only way to produce a combination of the cited references that results in the claimed invention is as a result of an impermissible hindsight reconstruction of the invention. *See id.*

Even if the Traderonline and Dean references were to be combined, the resulting combination would not result in the invention as claimed. First, as discussed above, the references fail to teach or suggest certain claim limitations. In addition, a combination of

Traderonline and Dean would likely result in a system in which web addresses for one or more of the Traderonline sites are stored on a smart card or in a database referenced by the smart card. Nothing suggests that the Traderonline sites in such a scenario would store personal information including preferred providers. As such, the combination would not result in identifying a provider from a list of preferred providers included in personal information associated with a domain name that is included in the request.

**D. The Cited References Fail to Teach or Suggest the Claimed Techniques with Respect to Independent Claims 45, 53, and 61.**

Claim 45 is directed to identifying one or more providers in response to a search request without additional search information being directly provided by the consumer, wherein the search request has a single set of characters forming a plurality of fields, a first field having a common name as between different search requests and a second field identifying the type of goods or services to be searched without specifying a specific provider of goods or services. None of the cited references disclose the limitations of claim 45.

The Traderonline reference discloses a family of websites that each, once a user loads a particular website, allow users to search for items using parameters selected by the user. Although accessing the Traderonline websites allows a user to perform a search, the reference does not disclose or suggest a search request that itself has a single set of characters forming a plurality of fields, a first field having a common name as between different search requests and a second field identifying the type of goods or services to be searched without specifying a specific provider of goods or services. Instead, a user performs a search by selecting parameters on a Traderonline website, not as a result of submitting a Traderonline web address. Thus, the Traderonline references also does not disclose or suggest identifying one or more providers in response to a search request without additional search information being directly provided by the consumer.

The Dean reference fails to overcome the deficiencies of the Traderonline reference. For example, Dean fails to disclose or suggest a search request that itself has a single set of characters forming a plurality of fields, a first field having a common name as between different

search requests and a second field identifying the type of goods or services to be searched without specifying a specific provider of goods or services.

Assuming that there was some motivation to combine the Traderonline and Dean references, the combination would not produce the invention as recited in claim 45. In particular, even assuming the Traderonline reference discloses multiple domain names, as asserted by the Examiner, there is no teaching or suggestion that such domain names themselves would represent search requests. Furthermore, although Dean discloses a system that returns user specific data, there is simply no suggestion or motivation to return such user specific data in response to a request that includes a single set of characters forming a plurality of fields, a first field having a common name as between different domain names and a second field identifying the type of goods or services.

Accordingly, claim 45 and its dependent claims are allowable over the cited references. Claims 53 and 61 include limitations similar to those discussed in connection with claim 45, and thus claims 53 and 61 and their respective dependent claims are also allowable over the cited references.

**E. The Cited References Fail to Teach or Suggest the Claimed Techniques with Respect to New Dependent Claims 81-84.**

New claims 81-84 depend from independent claim 1. New claim 81 recites that "the updated personal information is accessible by the system for use in identifying a provider based upon the subsequent request and the updated personal information." Support for this limitation can be found in the original application at least at page 23, lines 1-4, page 24, line 16 to page 25, line 2, page 26, lines 7-12, and page 27, lines 3-4. New claim 82 recites "identifying, responsive to the subsequent request, at least one provider wherein the updated personal information is accessible by the system for use in completing a transaction between the consumer and a selected one of the at least one provider." Support for this limitation can be found in the original application at least at page 14, lines 1-14, page 23, lines 1-4, page 26, lines 7-12, and page 27, lines 3-4. New claim 83 recites that the updated personal information comprises payment information. Support for this limitation can be found in the original application at least at page

14, lines 1-14, and page 23, lines 1-4. New claim 84 recites that the personal information further includes at least one personal purchasing preference and identifying at least one name of at least one provider is further based on a personal purchasing preference included in the personal information. Support for this limitation can be found in the original application at least at page 14, lines 1-14, page 23, lines 1-4, page 24, line 16 to page 25, line 2, page 26, lines 7-10, and page 27, line 3. In addition to the limitations discussed above with respect to independent claim 1, none of the cited references teach or suggest these claim limitations in the context of a method as recited in claim 1. Accordingly, claims 81-84 are allowable over the cited art.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Enclosed is a \$36.00 check for excess claim fees and a \$55.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Spencer C. Patterson', written over a horizontal line.

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